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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,773	10/11/2000	Timothy L. Racette	99556466	5174
26565	7590	06/22/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP P.O. BOX 2828 CHICAGO, IL 60690-2828			CARRILLO, BIBI SHARIDAN	
			ART UNIT	PAPER NUMBER
			1746	
DATE MAILED: 06/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,773

Applicant(s)

RACETTE ET AL.

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-102 and 104-109 is/are pending in the application.
- 4a) Of the above claim(s) 3-58, 61, 68-70, 74-87, 89-102 and 105-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 59, 60, 62-67, 71-73, 88 and 104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-102 and 104-109 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. In a further interview with Mr. David Fournier, on 6/8/2005, the examiner explained that the response to the restriction requirement was improper since claims 3, 11, 17, 61, 74-87, and 109 were elected and these particular group of claims were chemically different from the single disclosed elected species of claim 2. To further expedite the case, the examiner requested that applicant further elect claims which corresponded to the originally elected disclosed species of claim 2. Additionally, applicant had also elected cancelled claim 103. Mr. Fournier further elected with traverse claims 2, 59-60, 62-67, 71-73, 88 and 104. Therefore, the non-elected group include claims 3, 11, 17, 61, 74-87, and 109.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 2, 59-60, 62-67, 71-73, 88, and 104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite because it is unclear what one of ordinary skill in the art would consider as "sufficient time period" or "desired level of contaminant". Claim 71 is indefinite because it is unclear how a furniture can be considered a textile. Claim 88 is indefinite because it is not further limiting. Claim 104 is indefinite because it is unclear what one of ordinary skill in the art would consider as a "significant portion". Claims 65-

66 are indefinite because it is unclear whether the pressure recited is the pressure at which the organic solvent is being removed by the fluid.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2, 59-60, 62-64, 65-66, 71-73, 88, and 104 are rejected under 35 U.S.C. 102(e) as being anticipated by DeYoung et al. (6148645).

In reference to claims 2 and 88, DeYoung et al. teach a method of dry cleaning fabrics. In col. 9, lines 10-15, DeYoung et al. teach pumping liquid carbon dioxide cleaning solution into the wash vessel after the detergent formulation has been transferred to the wash vessel. Specifically, the detergent formulation is transferred to the wash vessel, followed by liquid CO₂ cleaning solution. In col. 2, lines 20-35, DeYoung et al. teach a detergent formulation comprising an organic co-solvent and up to 10% water. The organic solvent of claim 2 reads on the co-solvent of dipropylene glycol butyl ether. In col. 4, lines 52-63, DeYoung teaches co-solvents which include polyalkylene glycol (i.e. glycol n-butyl ether). Col. 12, lines 63 teaches dipropylene glycol monobutyl ether. In reference to removing a portion of the organic solvent from the substrate, the limitations are met as a result of the pumping of the detergent solution through the wash vessel and also the replacement of the detergent formulation by liquid

carbon dioxide. Claims 59-60 are inherently met since DeYoung teaches the same composition of dipropylene glycol butyl ether, as recited in the claimed invention. The limitations of claims 59-60 are chemical characteristics of the composition. In reference to claim 62, refer to col. 4, line 25. In reference to claims 63-64, refer to col. 10, line 62. In reference to claims 65-66 and in view of the indefiniteness, the limitations are met by DeYoung since DeYoung teaches the same composition of CO₂ as the claimed invention. In reference to claim 71, refer to col. 4, lines 8-15. In reference to claims 72-73 and 104, refer to col. 4, lines 1-7.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeYoung et al. (6148645) in view of Stucker (WO96/15304).

DeYoung et al. teach carbon dioxide, but fails to teach other pressurized fluid solvents comprising xenon, nitrous oxide, or sulfur hexafluoride. Stucker teaches that it is well known to use pressurized fluid solvents for dry-cleaning of garments (page 1). On page 10, Stucker teaches that the pressurized fluid includes nitrous oxide. It would have been obvious to a person of ordinary skill in the art to modify the method of DeYoung to include equivalent pressurized solvents, such as nitrous oxide, as taught by Stucker, for purposes of performing the same function.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 2, and 63-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10-11, and 13 of U.S. Patent No. 6755871 in view of DeYoung et al. (6148645).

Although the conflicting claims of Damaso are not identical, they are not patentably distinct from each other because the claims are directed to cleaning textiles with an organic solvent of dipropylene glycol ether, followed by removal with a pressurized fluid of liquid carbon dioxide. Damaso fails to teach the organic solvent comprising less than 50% water. DeYoung teaches low water content detergent formulations containing the organic co-solvent of dipropylene glycol monobutyl ether (col. 8, lines 1-17) for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles. It would have been obvious to a person of ordinary skill in the art to modify the method of Damaso, to include low water content detergent formulations, as taught by DeYoung, for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles.

11. Claims 2, 60, and 63-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 7-10, and 12 of U.S. Patent No. 6736959 in view of DeYoung et al. (6148645).

Although the conflicting claims of Racette et al. are not identical, they are not patentably distinct from each other because the claims are directed to cleaning textiles with an organic solvent of dipropylene glycol ether, followed by removal with a pressurized fluid of liquid carbon dioxide. Racette et al. fail to teach the organic solvent comprising less than 50% water. DeYoung teaches low water content detergent formulations containing the organic co-solvent of dipropylene glycol monobutyl ether (col. 8, lines 1-17) for purposes of being immiscible with liquid carbon dioxide in order to

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promote turbulent conditions effective for cleaning of textiles. It would have been obvious to a person of ordinary skill in the art to modify the method of Racette et al., to include low water content detergent formulations, as taught by DeYoung, for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles.

12. Claims 2, 60, and 63-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10-11, and 13 of U.S. Patent No. 6355072 in view of DeYoung et al. (6148645).

Although the conflicting claims of Racette et al. are not identical, they are not patentably distinct from each other because the claims are directed to cleaning textiles with an organic solvent of dipropylene glycol ether, followed by removal with a pressurized fluid of liquid carbon dioxide. Racette fails to teach the organic solvent comprising less than 50% water. DeYoung teaches low water content detergent formulations containing the organic co-solvent of dipropylene glycol monobutyl ether (col. 8, lines 1-17) for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles. It would have been obvious to a person of ordinary skill in the art to modify the method of Racette, to include low water content detergent formulations, as taught by DeYoung, for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles.

13. Claims 2, 60, and 63-65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2,

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8-13, 15-16, 21-26 of copending Application No. 10/797516 in view of DeYoung et al. (6148645).

Although the conflicting claims of Racette et al. are not identical, they are not patentably distinct from each other because the claims are directed to cleaning textiles with an organic solvent of dipropylene glycol ether, followed by removal with a pressurized fluid of liquid carbon dioxide. Racette fails to teach the organic solvent comprising less than 50% water. DeYoung teaches low water content detergent formulations containing the organic co-solvent of dipropylene glycol monobutyl ether (col. 8, lines 1-17) for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles. It would have been obvious to a person of ordinary skill in the art to modify the method of Racette, to include low water content detergent formulations, as taught by DeYoung, for purposes of being immiscible with liquid carbon dioxide in order to promote turbulent conditions effective for cleaning of textiles.

This is a provisional obviousness-type double patenting rejection.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayday et al. teaches a biodegradable dry cleaning solvent. DeYoung et al. teach cleaning with carbon dioxide. Scheper et al. teach contacting with xenon gas followed by glycol ether. Racette et al. teach cleaning with an organic solvent.

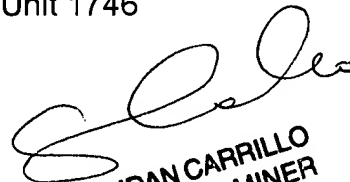
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER